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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,752	07/07/2005	Georg Werner Reppel	47192/312177	6817

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ATLANTA, GA 30309

EXAMINER
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SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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04/19/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/524,752</p>	<p><b>Applicant(s)</b> REPPPEL, GEORG WERNER</p>	
	<p><b>Examiner</b> John P. Sheehan</p>	<p><b>Art Unit</b> 1793</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-5 and 7-23.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☒ Other: See Continuation Sheet.

/John P. Sheehan/  
Primary Examiner  
Art Unit: 1793

Continuation of 3. NOTE: The proposed amendment attempts to add the following limitations to the claims that have never previously appeared in the claims and therefore have not been previously considered:

- I. In claim 1, line 10 and 11, "a hydrogenation/dehydrogenation treatment without homogenization treatment";
- II. In claim 1, line 15 and claim 2, line 10, "hydride of the SE-TM-B alloy";
- III. The limitation appearing in claim 1, lines 20 to 23 and claim 2, lines 18 and 19;
- IV. In claim 12, "treating the magnetic powder" which encompasses any treatment as opposed to the specific treatment previously recited in claim 12.

The proposed amendment also raises the issue of new matter in that the limitation, "having a crystallographic orientation that matches a crystallographic orientation of said TMxB phase" appearing in claim 1, lines 21 to 23 and claim 2, lines 18 and 19 does not find support in the application as filed. Applicants have cited paragraphs 19 and 39 of the published application as support. However neither of these paragraphs mentions the TMxB phase.

Continuation of 11. does NOT place the application in condition for allowance because: applicants point out differences between Takeshita and Yajima and then argue that these two references are not combinable. It is pointed out that the Examiner is relying on Yajima to show that the crystal grain size of R-Fe-B alloys is less than 10 microns regardless of how the alloy is made (column 2, lines 37 to 61). As set forth in the statement of the rejection:

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because Yajima '208 teaches that the typical R-TM-B magnet has a crystal grain size of less than 10 micron. In view of this, it would be expected that the R-TM-B alloys taught by Takeshita '374 would have crystal grain sizes of 10 microns or less which is encompassed by the crystal grain size of less than 10 microns recited in claim 1.

Regarding the rejection based on Takeshita et al. (US Patent 5,110,374) in view of either Kim (US Patent 5,091,020) or Kaneko et al. (US Patent 6,149,681) further in view of Yajima et al. (US Patent 5,049,208), applicant points out differences between each of the references and then argues that the rejection "is the result of the combination of fundamentally incompatible references and for at least this reason does not establish a prima facie case of obviousness". This is not persuasive. Applicant has not explained why the differences make it improper to combine the references. Applicant, citing MPEP 2112, argues that although Kim teaches the use of scrap magnetic material, the Examiner has not explained why the scrap must necessarily be anisotropic and that if the Examiner is basing the use of Kim on personal knowledge "then this should be placed into the record in accordance with 37 C.F.R. § 1.104(d)(2)". Regarding applicant's citation of MPEP 2112, it is noted that this section of the MPEP covers three pages with 5 subsections. Applicant has not indicated which of the 5 subsections that applicant is relying on in making this argument. Further, the Examiner is not relying on personal knowledge in making this rejection. Kim defines scrap as including sintered magnets that are inferior in some way (column 1, lines 32 to 40). As taught by Kim sintered magnets encompass magnets that have been aligned in a magnetic field, that is, that are anisotropic (column 3, lines 30 to 35).

Continuation of 13. Other: Regarding the replacement drawings and the substitute specification, applicant is advised that each is acceptable but in accordance with MPEP 714.20 (List of Amendments Entered in Part) neither has been entered.